

REMARKS

Claim 8 has been amended above, without prejudice, to define a more traditionally claimed method. Claim 16 is similar to unamended claim 3, further reciting the length described, for example, on page 11, lines 21-23 of the specification. No new matter has been added.

The applicants elect, with traverse, the subject matter of the Examiner's Group I. Reconsideration and withdrawal of the restriction requirement are requested as the applicants believe the subject matter of the Examiner's Groups I and II share the same or corresponding special technical feature.

Specifically, the Examiner is understood to assert that the cited art (Gurtler Accession No. U11789) describes a nucleotide sequence which specifically hybridizes to SEQ ID NO 2, or a fragment of at least 20 contiguous nucleotides thereof, as defined in unamended claim 3. The Examiner is further understood to have concluded that the as the technical feature of at least 20 contiguous nucleotides of SEQ ID NO:2 allegedly fails to make a contribution over the prior art, there is allegedly no special technical feature between the subject matter of the Examiner's Groups I and II.

Claim 3 above, and new claim 16 which is based on unamended claim 3, are patentable over Gurtler (Accession No. U11789). Specifically, the Examiner has not indicated that SEQ ID NO:1 or any claimed fragment thereof is taught by Gurtler. Moreover, Gurtler teaches a sequence of 632 nucleotides which fails to specifically describe or suggest the invention of claim 16.

Withdrawal of the restriction requirement as between the subject matter of the Examiner's Groups I and II, and examination of all of the claims are requested.

The applicants further elect, with traverse, the set of two polynucleotide probes consisting of SEQ ID NOs: 17 and 19. Reconsideration and withdrawal of this further election requirement are requested as the Examiner has failed to demonstrate that the claimed probes fail to make a contribution over the prior art, such as by reference to any art which anticipates the claimed sequences.

The Examiner is requested to appreciate that the present application is a 371 U.S. national phase of a PCT application wherein the PCT principles of unity of invention are believed to apply.

The Examiner is understood to have asserted, for example, that sequences are *per se* separately patentable, without any comparison to the art or technical references or analysis of the present specification to establish a lack of unity of invention. The Examiner indicates in the Office Action of September 27, 2006 that the restriction requirement is appropriate because

“since polynucleotides are structurally distinct, they fail to share a common structure, i.e., a significant structural element. The sugar-phosphate backbone cannot be considered a significant structural element, since all nucleic acid molecules share it. Therefore the 43 polynucleotides molecules [sic] do not share any significant structural element and cannot be considered as having the same or corresponding technical feature.” See page 3 of the Office Action dated September 27, 2006.

The applicants submit, with due respect, that the Examiner has not established that the claimed invention fails to share a common special technical feature and that there is a lack of unity of invention.

All of the claimed probes share a common property and activity. Specifically, the probes provide for the detection and/or identification of *Staphylococcus* species

(Specification, p.7, l. 14-19) as all of the probes are able to hybridize to the sequences of one species.

MPEP § 1850 states as follows, in relevant part (emphasis added):

37 CFR 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

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THE REQUIREMENT FOR "UNITY OF INVENTION"

Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (PCT Article 3(4)(iii) and 17(3)(a), PCT Rule 3.1, and 37 CFR 1.475). Observance of this requirement is checked by the International Searching Authority and may be relevant in the national (or regional) phase.

The decision in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986) held that the Patent and Trademark Office interpretation of 37 CFR 1.141(b)(2) as applied to unity of

invention determinations in international applications was not in accordance with the Patent Cooperation Treaty and its implementing regulations. In the Caterpillar international application, the USPTO acting as an International Searching Authority, had held lack of unity of invention between a set of claims directed to a process for forming a sprocket and a set of claims drawn to an apparatus (die) for forging a sprocket. The court stated that it was an unreasonable interpretation to say that the expression "specifically designed" as found in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).

Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. No change was made in restriction practice in United States national applications filed under 35 U.S.C. 111 outside the PCT.

In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.

PCT Rule 13.2, as it was modified effective July 1, 1992, no longer specifies the combinations of categories of invention which are considered to have unity of invention. Those categories, which now appear as a part of Chapter 10 of the International Search and Preliminary Examination Guidelines, may be obtained from WIPO's website (www.wipo.int/pct/en/texts/gdlines.htm). The categories of invention in former PCT Rule 13.2 have been replaced with a statement describing the method for determining whether the requirement of unity of invention is satisfied. Unity of invention exists only when there is a technical relationship

among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. Chapter 10 of the International Search and Preliminary Examination Guidelines also contains examples concerning unity of invention.

A. Independent and Dependent Claims

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

As the independent claims avoid the prior art, the above strongly suggests that the dependent claims, reciting specific probes, should not lack unity of invention.

The Examiner is not believed to have demonstrated that the pending claims do not share the same or corresponding special technical feature, as described in MPEP § 1850, and the restriction requirement of September 27, 2006, therefore should be withdrawn, and all the claims examined on the merits.

Rejoinder and allowance of any claim defining a method of making and/or using a product defined by an allowable claim, at an appropriate time, are requested.

Claeys et al.
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An early and favorable Action on the merits of all of the claims is requested.

Respectfully submitted,

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